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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.
08/421,055	04/12/95	JOHNSON	M	49286USA9C

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EXAMINER	
GALLAGHER, J	

ART UNIT	PAPER NUMBER
1733	23

DATE MAILED: 08/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)	
08/[illegible]		
Examiner	Group Art Unit	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 6-32 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 6-32 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☑ Notice of Reference(s) Cited, PTO-892

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other _____

Office Action Summary

1. Applicants' Preliminary Amendment, filed 29 June 2001, has been received and made of record.

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no apparent explicit support in the specification for the limitation in claims 28-29 (and claims dependent therefrom) requiring the dimensionally stable film to HAVE a smooth surface, such that these claims and the disclosure should be brought into correspondence, apparently most easily by inserting the term "have and" after "films" on page 27 line 17 of the specification; further along this line, it is felt that the word "comprising" in claim 29 at line (a)8 should be changed to "having"; and (b)9 should be changed to "composed of".

3. Claims 6-28 and 32 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the word "topography" (which is nowhere employed in the specification in this regard) should be/have been deleted from line 7 of claim 6 (preferably along with the remainder of this line), and also from line 3 of claim 16 and line 10 of claim 28, the COMPLETE limitation found and

held to be objectionable (i.e. containing new matter) by the Examiner and acquiesced in the BPAI being as set forth at page 4 lines 12-16 of the Board decision rendered 30 January 2001; further along this line, the ONLY apparent material which is available to applicants for use in defining and claiming their dimensionally stable film is held/seen to be as set forth at page 27 line 10 thru page 30 line 12 of applicants' specification.

4. Claims 6-32 are rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for (a) the use of a shrinkable dimensionally stable film to control the melt flow of the adhesive composition; and (b) a dimensionally stable film cross-linked to an unspecified degree or extent, does not reasonably provide enablement for just any (a) dimensionally stable film (claims 6-32); and (b) degree of cross-linking for this aforementioned film (claims 14-15 and 30, as noted by the BPAI in Footnote 2 on page 7 of their aforementioned decision). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. Further along this line, N.B. page (a) 28 lines 23-25; and (b) 27 lines 20-22 of applicants' specification.

5. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper

timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 6-32 are further rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 12-13 and 20-23 of U.S. Patent No. 5,964,979 (to George et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because the same basic inventive concept is held to be involved in both instances, the (broader) instant claims being held/seen to encompass the (narrower) patented claims within their scope and definition, with a significant (i.e. near total) amount of overlap between these two respective sets of claims.

7. Although the Examiner feels that the disclosure of the (formerly applied) Wagner et al. reference is consistent/in agreement with applicants' specification at page 6 lines 11-21, the BPAI disagreed.

8. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 6-8, 14-16, 20-26 and 29-32 are further rejected under 35 U.S.C. § 103(a) as being unpatentable over Kinzer et al. taken in combination with either Harrison et al. or Smith et al. (all newly applied).

Kinzer et al. disclose that it is known to bond or join (e.g. metal) substrates together in an automotive environment utilizing an adhesive article composed of a dimensionally stable (e.g. thermoplastic or thermoset resin film) carrier or substrate in combination with a heat activated and curable adhesive. (Column 1 lines 8-27, N.B. column 2 lines 1-4, column 11 lines 50-52, N.B. column 12 lines 16-26).

Harrison et al. (Fig. 3, Abstract, column 1 lines 6-8 and 42-46, column 2 lines 27-28 and 40-68, column 3 lines 1-14 and 52-53, N.B. column 4 lines 6-22 and 51-52) and Smith et al. (Figs. 3-5, Abstract, column 1 lines 10-23, column 2 lines 66-68, column 3 lines 1-12, 23-35 and 45-54, column 4 lines 41-43,

column 5 lines 12-45) both disclose that it is known to employ a heat activatable and curable adhesive to effect and/or seal joints between substrates in an automotive/vehicular environment, the adhesive being flowable upon heating such that any gaps, voids, irregularities etc. in the substrates and/or joint area are filled/sealed. It would have been obvious to one of ordinary skill in this art to employ the adhesives of either Harrison et al. or Smith et al. in/in conjunction with the invention/adhesive article of Kinzer et al. in place of the corresponding, analogous adhesive employed therein, mere substitution of one known heat curable adhesive for another (and in/from an identical environment) being involved. In similar manner, it would have been obvious to one so skilled to employ the documented substrate/carrier member of Kinzer et al. in conjunction with the adhesives of either Harrison et al. or Smith et al., mere utilization of a known conventional element in combination with a known adhesive being involved, the environment of all three references being (again) identical.

10. Claims 12-13 are further rejected under 35 U.S.C. § 103(a) as being unpatentable over Kinzer et al. taken in combination with either Harrison et al. or Smith et al., and further in combination with Pletcher (already of record).

Pletcher discloses that, in the construction of adhesive (e.g. tape) composites of the type/similar to those of

Kinzer et al. it is known to employ as the material of construction for the backing/base layer thereof, in addition to polyurethane, polyesters (e.g. MYLAR), polyolefins (to include foams) etc. (N.B. column 8 lines 57-68), such that it would have been obvious to one of ordinary skill in this art to employ any of these conventional documented backing layer materials in the invention/adhesive article of Kinzer et al. (as further modified by the remaining secondary references) in place of the corresponding, analogous substrate/carrier layer employed therein; mere substitution of one known such material for another involved.

11. Claims 9 and 28 are further rejected under 35 U.S.C. § 103(a) as being unpatentable over Kinzer et al. taken in combination with either Harrison et al. or Smith et al., and further in combination with Schappert et al. (also already of record).

Schappert et al. disclose that epoxy-polyester blends are known to be employed as adhesives in the bonding of automobile components (Abstract, column 1 lines 10-11 and 61-68, column 2 line 1 thru column 3 line 8, N.B. column 6 lines 30-41), such that it would have been obvious to one of ordinary skill in this art to employ such a conventional, documented adhesive in the invention/adhesive article of Kinzer et al. (as further modified by the remaining secondary references) in place of the

corresponding, analogous adhesive employed therein; mere substitution of one known automotive adhesive for another involved.

12. Claims 17-19 and 27 are further rejected under 35 U.S.C. § 103(a) as being unpatentable over Kinzer et al. taken in combination with either Harrison et al. or Smith et al., and further in combination with Kan (also ready of record).

Kan discloses that it is both known and desirable to apply a latex (which term is held/seen to encompass (latex) paint within its scope and definition) film to a plastic substrate, a reactive/chemical bond being formed between film and substrate (Abstract, column 1 lines 6-29, column 2 lines 36-42, column 5 lines 12-51), such that it would have been obvious to one of ordinary skill in this art to employ such a beneficially documented procedure in conjunction with the invention of Kinzer et al. (i.e. the exposed substrate/carrier layer thereof) as further modified by the remaining secondary references, wherever deemed appropriate i.e. desirable and/or necessary.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. J. Gallagher whose telephone number is (703) 308-1971. The examiner can normally be reached on M-F from approximately 8:30 A.M. to 5 P.M. The examiner can also be reached on alternate N/A.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for this Group is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661/0662.

JJGallagher:cdc
July 19, 2001

JOHN J. GALLAGHER
PRIMARY EXAMINER
ART UNIT 1733